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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,109	02/17/2004	Jeffrey Jovan Philyaw	RPXC - 26,630	6493
25883	7590	04/08/2009		
HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715			EXAMINER HOANG, HIEU T	
			ART UNIT 2452	PAPER NUMBER
			NOTIFICATION DATE 04/08/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@dalpat.com

### Office Action Summary

**Application No.**

10/780,109

**Applicant(s)**

PHILYAW, JEFFREY JOVAN

**Examiner**

HIEU T. HOANG

**Art Unit**

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/19/2009 has been entered.
2. Claims 1-20 are pending.

***Response to Amendment***

3. The double patenting rejection is withdrawn due to the filing of the terminal disclaimer on 01/16/2008 and the amendment on 02/19/2009.

***Response to Arguments***

4. Applicant's arguments have been fully considered but are moot in view of new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Consider claim 1 (and similarly claim 11), the claim recites "*the representation of the MRC having no routing information contained therein but the MRC having an association with a remote location on the network, which routing information thereto is contained at an intermediate location on the network.*" Given broadest interpretation to "routing information," the routing information can be read as an association with a remote location on the network to which the device connects to get more routing information. Therefore, it is contradictory how the representation of the MRC has no routing information contained therein but the MRC having an association with a remote location on the network (the association is some kind of routing information). Correction is required. Furthermore, reciting "routing information" alone is extremely vague. Routing information for/to/from what, to do what? The claimed routing information is contained at an intermediate location, but no use of the routing information is recited in the claims.

7. For claim 1, the claim recites "the MRC having an association with a remote location on the network" on lines 10-12 and "the remote location associated with the representation of the MRC." Because the MRC and the representation of the MRC are two different elements, it is vague what is meant by the remote location associated with the representation of the MRC. For claim 1, "routing information" on line 12 is vague for not referring back to previously recited "routing information." "The step of extracting" on line 15 lacks antecedent basis. "The information" on line 19 lacks antecedent basis. On line 18, "the representation of the MRC information *as defined at the intermediate location*" is vague. What defined at the intermediate location is not the representation.

The intermediate location only contains the routing information (lines 12-13) and does not define any representation of the MRC information.

8. Claim 1 is incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: retrieving routing information from the intermediate location. Lacking of this step, there is no relationship between the routing information and the remote location.

9. Claim 1 recites "substantially immediate feedback is provided to the user." Substantially is a relative term, which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Furthermore, it is vague what kind of feedback is provided to the user. Furthermore, "such that when displayed..." on line 21 is an intended use of the displaying step.

10. Claim 11 is rejected for the same rationale as in claim 1.

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. Consider claim 1 (and similarly claim 11), the claim recites "*the representation of the MRC having no routing information contained therein.*" Contradictorily, the specification recites "the MRC (1606) having associated therewith routing information corresponding to a remote location" (abstract of the invention).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst Jr. et al. (US 2001/0011276, hereafter Durst), in view of Wilz, Sr. et al. (US 5,992,752, hereafter Wilz), further in view of Van Ryzin (US 2002/0059241)

15. For claim 1, Durst discloses a method for a user accessing information on a network, comprising the steps of:

providing a remote control device operating in a first and control mode with internally generated control commands and in a second and scanning mode ([0011], a TV remote control with bar code scanner);

in the control mode, controlling an appliance at a user location by wirelessly transmitting the control commands to the appliance ([0011], TV remote control for controlling a TV);

in the scanning mode:

forming a representation of machine recognizable code (MRC) information contained within an MRC using the remote control device, the MRC having an association with a remote location on the network ([0011], the remote control scans a bar code associated with a network resource location);

Durst does not explicitly disclose:

wirelessly transmitting the representation of MRC information contained within the MRC to a network interface device in response to the step of extracting;

connecting the user location over the network to the remote location associated with the representation of the MRC information and downloading the information therefrom; and

displaying the downloaded information on a display at the user location, such that when displayed, substantially immediate feedback is provided to the user in response to the step of scanning.

However, Wilz discloses:

wirelessly transmitting the representation of MRC information contained within the MRC to a network interface device in response to the step of extracting (fig. 1B2, data transmission of decoded URL to an internet terminal);

connecting the user location over the network to the remote location associated with the representation of the MRC information and downloading the information therefrom (fig. 1B4, fig. 4, internet terminal with browser for connecting and downloading web page information associated with the received URL); and

displaying the downloaded information on a display at the user location, such that when displayed, substantially immediate feedback is provided to the user in response to the step of scanning (fig. 1B4, fig. 4, internet terminal with browser for displaying web page information associated with the received URL).

It would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Durst and Wilz to take advantage of the internet terminal with browser of Wilz to display product-related information after scanning the bar code.

Durst-Wilz does not teach the representation of the MRC having no routing information contained therein, routing information to the remote location is contained at an intermediate location on the network, and the routing information as defined at the intermediate location.

However, in the same field of endeavor, Van Ryzin discloses the representation of the MRC having no routing information contained therein (fig. 1, fig. 2, scan bar code with product code number), routing information to the remote location is contained at an intermediate location on the network, the routing information as defined at the intermediate location (fig. 2, send product code number to an intermediate server to retrieve resource routing internet address).

It would have been obvious for one skilled in the art at the time of the invention to alternate the teachings of Durst-Wilz with Van Ryzin such that an intermediate server is used to provide routing information automatically based on scanned product code information so that vendor does not have to encode routing information in a bar code but instead routing information can be provided centrally or at an intermediate or third party server therefore provide more convenience to the vendors and more centralized services.

16. For claim 2, Durst-Wilz-Van Ryzin further discloses the network is a global communication network (Wilz, fig. 4, 5, URL, internet).

17. For claim 3, Durst-Wilz-Van Ryzin further discloses the step of forming comprises scanning the MRC with a scanner, which scanner is incorporated into the remote control device (Durst, [0011]).

18. For claim 4, Durst-Wilz-Van Ryzin further discloses the MRC in the step of forming is a UPC associated with an article of commerce (Wilz, col. 25 line 30, UPC).

19. For claim 5, Durst-Wilz-Van Ryzin further discloses the MRC in the step of forming is associated with a product and the remote location on the network is associated with the product (Wilz, fig. 1D1, product related URL, Van Ryzin, fig. 2, internet address of product related resources).

20. For claim 6, Durst-Wilz-Van Ryzin further discloses the display in the step of displaying is disposed in close association with the network interface device (Wilz, fig. 1B4, internet terminal with display browser).

21. For claim 7, Durst-Wilz-Van Ryzin further discloses the network interface device in the step of wirelessly transmitting and the display in the step of displaying comprise a personal computer (Wilz, fig. 4, a PC, Van Ryzin, fig. 2, PC).

22. For claim 8, Durst-Wilz-Van Ryzin further discloses the step of connecting to the remote location and downloading the information therefrom comprises: transmitting the representation of the MRC information to an intermediate location on the network having a relational database associated therewith, which relational database has contained therein relationships between a plurality of representations of MRCs and routing information on the network; comparing the received representation of the MRC information with information in the relational database to determine if a match exists; and if a match exists, accessing the remote location and downloading the information therefrom to the display (Wilz, col. 5 lines 18-22, fig. 11B, col. 27 lines 36-67, an intermediate relational database system RDBMS used for storing information on associated URLs, matching a URL to download information on scanned items; Van Ryzin, fig. 1 and 2, remotely retrieving routing IP address for a product resource then use the routing IP address to link browser to the product resource).

23. For claim 9, Durst-Wilz-Van Ryzin further discloses the display and the network interface device are disposed at the user location remote from the remote location on the network (Wilz, fig. 2, fig. 4, display and internet terminal are at the user location) and the step of accessing information from the remote location comprises transferring the routing information from the relational database back to the user location, the user location and the network interface device then accessing the remote location and the information therefrom for download therefrom (Wilz, fig. 2, fig. 4, internet terminal for downloading and displaying information related to the scanned bar code, multiple related links are returned; Van Ryzin, fig. 2, remotely retrieving routing IP address for a product resource then use the routing IP address to link browser to the product resource).

24. For claim 10, Durst-Wilz-Van Ryzin further discloses the step of forming comprises extracting MRC information with a portable extracting device and the step of wirelessly transmitting comprises the steps of: storing the extracted MRC information in a memory; transmitting the stored extracted MRC information to the network interface device in a predetermined number of steps; at the network interface device, receiving the transmitted MRC information and, upon receiving any of the transmitted stored information, utilizing that received stored information to connect to the remote location on the network, while ignoring subsequent transfers of extracted MRC information from

the portable extraction device (Wilz, fig. 1B4, PProM, internet terminal receives the URL then connects to web page to get information from the URL).

25. For claims 11-20, the claims are rejected for same rationale as in claims 1-10 respectively.

### ***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu T. Hoang whose telephone number is 571-270-1253. The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HH

/Kenny S Lin/

Primary Examiner, Art Unit 2452